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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,725	06/27/2003	Diane C. Breidenbach		6496

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Thomas A. O' Rourke  
BODNER & ROURKE, L.L.P.  
425 Broadhollow Road  
Melville,, NY 11747

EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/607,725

Applicant(s)

BREIDENBACH ET AL.

Examiner

Kathleen J. Prunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 27, 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters “15”, “22” and “23” have all been used to designate the same element in Fig. 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. Figs. 7B and 7C fail to correspond with the description given on page 12 at line 9 with respect to the screw means being a threaded rod. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to because: (A) Fig. 1A fails to correspond with its description on line 18 of page 7 (it is suggested that a section line be drawn through Fig. 1 to indicate what is being shown in Fig. 1A); (B) Fig. 1 fails to properly show that “61” is the base of the plug 59 (it presently shows a mid point); (C) in Fig. 4, “33” should be changed to --30-- since 33 is the open end of the reservoir 30 and 32 is the tip of the reservoir 30; (D) in Fig. 6B, it is unclear as to what is being shown in the figure; (E) in Fig. 7C, the lead line for “26” is lacking; (F) Fig. 8 should either be bracketed to indicate that the different parts constitute a single entity or the views should be labeled or numbered separately; (G) in Fig. 12B, the lead line for “30” is lacking; and (H) Figs. 2, 3, 6A, 6B, 9, 10A, 10B, 11A, 11B, 12A and 12B fail to show the proper cross hatching for sectional views. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as “means” and “said”, should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and **should not repeat information given in the title.** It should avoid using phrases which can be implied, such as, “The disclosure concerns”, “The disclosure defined by this invention”, “The disclosure describes”, etc.

2. The abstract of the disclosure is objected to because: (A) it uses the form and legal phraseology often used in patent claims, i.e., “means” and “comprising”; and (B) it repeats information given in the title. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: on page 1, in the paragraph beginning on line 2, the current status of the related applications should be included. Appropriate correction is required.

4. The following informalities in the specification are noted: (A) on page 4, in the amendment to lines 15-17, on line 2, “at” should read --and--; (B) on page 7, in the amendment to lines 7-8, on line 1, “prevent” should read --prevents--; (C) on page 7 line 17, --a-- should be inserted after “with”; (D) on page 9, line 9, a comma should be inserted directly after “17”; (E) on page 9, line 11, a comma should be inserted directly after “cap”; (F) on page 10, line 5, a comma should be inserted directly after “2001”, and “disclosures” should read --disclosure--; (G) on page 10, line 6, “are” should read --is--; (H) on page 10, in the sentence beginning on line 6, inconsistent reference is made to the fragrance/perfume container/dispenser; (I) on page 10, line 8, “22” should read --11--; (J) on page 11, in the amendment to lines 11-12, on line 1, “39” should read --34--; (K) on page 13, in the amendment to lines 14-15, “slot” should read --slit--;

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and (L) on page 14, in the amendment to lines 7-9, "tries" should read --traces-- and "front" should read --first--. Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed terminology. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claimed terminology which lacks such antecedent basis is as follows: (A) "a sidewall of said cap" (note claims 2 and 3); (B) "a hand hold" (note claim 20); and (C) "a protrusion" (note claim 28). Correction is required.

6. The following informalities in the claims are noted: (A) in claims 1 and 30, on line 4, --said-- should be inserted after "discharging"; (B) in claim 1, on line 5, --said-- should be inserted after "lip" and "a" should read --the--; (C) in claim 16, on line 2, --the-- should be inserted before "product"; (D) in claim 20, on line 2, --that-- should be inserted before "provides" and, on line 5, --the-- should be inserted before "product"; (E) in claim 21, on line 2, --the-- should be inserted before "lip"; (F) in claims 22 and 23, on line 2, --the-- should be inserted before "lip"; and (G) in claim 30, on line 5, --said-- should be inserted after "as" and "a" should read --the--. Appropriate correction is required.

### ***Double Patenting***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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9. Claim 29 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 of prior U.S. Patent No. 6,607,323. This is a double patenting rejection.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “The base 61 of the plug 59 is secured to the cap by any convenient means. One preferred means . . . is to provide the interior surface of the cap with a protruding member 62” (note lines 2-5 on page 15), does not reasonably provide enablement for “said plug is ‘adhered to’ said cap by means of ‘a protrusion’ ” as called for by claim 28. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

12. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 28 calls for “said protrusion having a hose adjacent to said cap” (note line 3). However, the originally filed disclosure fails to describe or support such a hose.

13. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a protruding member 62 having a head 63 that is larger than its stem 64” (note lines 4-5 on page 15), does not reasonably provide enablement for “said protrusion being wider at its tip than at its base” as called for by claim 28. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

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14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 4, 5, 7-14 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claim 4 is indefinite since it calls for windows on “both sides of the cap”. However, the configuration of the cap has not been recited so as to define what constitutes “both sides”.

17. Claim 5 is indefinite since it refers to “said window”. However, claim 2, from which claim 5 depends, calls for “one or more windows”.

18. Claims 7-14 are indefinite since they refer to “said product”. It is unclear as to which product is being referred to, i.e., the “pasty or semi soft lip product” of claim 1 or the “another product” of claim 6.

19. Claim 17 contains a term lacking proper antecedent basis. The claim recites the limitation “the threads” in line 4. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 20 contains a term lacking proper antecedent basis. The claim recites the limitation “the purchaser” in line 4.

### ***Claim Rejections - 35 USC § 102***

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claims 1, 15-19, 21-26 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Gueret. With respect to claims 1 and 30, Gueret discloses a lip product applicator for applying a lip product of liquid-to pasty consistency (note lines 9-16 in col. 1) having all the

claimed features including a body (constituted by lower part 2*b*, note Fig. 1) having extending therefrom a product reservoir 2, the reservoir 2 being hollow (note Fig. 2) and having a tip 6 extending from an end opposite the body 2*b*, the reservoir 2 having a means (constituted by neck 3) for discharging the product contained therein through an orifice 61 in the tip 6, and the tip 6 being tapered (note Figs. 1 and 2) and retaining the tapered shape as lip product is applied to the user's lips (note lines 40-52 in col. 4). With respect to claim 15, Gueret also discloses that the reservoir 2 has a round or circular side wall (note Figs. 1 and 3, and line 34 in col. 5). With respect to claim 16, Gueret further discloses that the reservoir 2 has a drive means (constituted by piston 4) for driving the product from the reservoir. With regard to claim 17, Gueret additionally discloses that the drive means is a disk (constituted by wall 41) positioned outside the reservoir 2 and secured within the body 2*b* of the applicator and that the disk 41 supports a screw means (constituted by screw threads 43*a*) having a driving member (constituted by drive stud 43) which rides upwardly or downwardly on the screw threads as the body of the applicator is turned (note lines 4-9 in col. 7). With regard to claim 18, Gueret further discloses that the driving member (constituted by drive stud 43) is prevented from turning by a guide member (constituted by slot 21). With regard to claim 19, Gueret also discloses that the guide member (constituted by slot 21) extends from an interior wall of the reservoir along at least a portion of its length and mates with a recess 21*b* on the driving member (note Fig. 1). With respect to claim 21, Gueret additionally discloses that the tip 6 has a tear drop shaped surface 63 (note Fig. 1) for applying the lip product to the user's lips. With respect to claim 22, Gueret also discloses that the surface 63 of the tip 6 is slightly concave along both vertical and horizontal axes (note Figs. 6, 7 and 10, and lines 57-59 in col. 3). With regard to claim 23, Gueret further discloses that the surface 63 is provided with a plurality of canals or channels for receiving the lip product (note lines 62-65 in col. 3). With regard to claim 24, Gueret also discloses a perimeter canal 15 (note Fig. 9). With respect to claim 25, Gueret additionally discloses a vertical canal 16 that extends downwardly from the uppermost orifice 61 (note Fig. 9). With respect to claim 26, Gueret also discloses that the tip 6*h* has at least one horizontal canal on its surface (note Fig. 13).



***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 2-5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Lang et al. Gueret further discloses that the lip product applicator has a cap 8. Although Gueret fails to disclose that the cap 8 has one or more viewing windows in a top and sidewall to permit viewing of the color or amount remaining of the lip product in the applicator, attention is directed to Lang et al. who disclose another lip product applicator having a cap 34-a, having a top and sidewalls, that is made of clear transparent material, thus forming viewing windows, in order that the purchaser may observe the color of the contents of the tube as well as permitting the observer to see the tube contents (note lines 40-48 in col. 4). It would have been obvious to one of ordinary skill in the lip product applicator art, at the time the invention was made, to provide the cap of Gueret with a top and sidewalls made of clear transparent material, thus forming viewing windows, in view of the teachings of Lang et al. in order that the purchaser may observe the color of the contents of the tube as well as permitting the observer to see the tube contents. Although it is considered that the material necessary to form the "viewing windows" of the cap is an obvious expedient to the skilled artisan, to use the material PETG, as called for by claim 5, to effect viewing is simply the result of optimization of the prior art teachings through routine experimentation, which is not a matter of invention, absent a showing to the contrary (see *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), and *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). With respect to claim 20, Lang et al. further teach the obviousness of forming the hand hold or finger holding portion 29-a (note lines 25-27 and 32-36 in col. 4) of transparent material (note lines 3-7 and 24-29 in col. 2), thus

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forming a viewing window, to permit the user to view the product's color and contents (note lines 49-55 in col. 4). It would have been obvious to one of ordinary skill in the lip product applicator art, at the time the invention was made, to form the hand hold or finger holding portion of Gueret of clear transparent material, thus forming a viewing window, in view of the teachings of Lang et al. in order that the purchaser may observe the color of the contents of the tube as well as permitting the observer to see the tube contents.

25. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Lang et al. as applied to claims 2-5 and 20 above, and further in view of Green. Gueret further discloses that the cap 8 has a plug constituted by downwardly extending portion 82 (note Fig. 2) that blocks the orifice 61 when the cap is in place. Although Gueret fails to disclose that the plug is inserted into the orifice, attention is directed to Green who discloses another lip product applicator having a cap provided with a plug, constituted by pin 50, that is inserted into the orifice or opening 29 (note Fig. 4), in order to form a tight seal of the orifice or opening 29 (note lines 33-36 in col. 1 and lines 4-11 in col. 4). It would have been obvious to one of ordinary skill in the lip product applicator art, at the time the invention was made, to provide the cap of Gueret with a plug or pin that is inserted into the orifice or opening in view of the teachings of Green in order to form a tight seal of the orifice or opening and thus avoid the possibility of lip product being dispensed while the applicator is stored in the user's pocket or purse. With respect to claim 28, although both Gueret and Green disclose that the plug is integrally formed with the cap, it is considered that to attach the plug to the cap by use of a complementary cooperating protrusion and recess in which the protrusion is wider at its head or tip than at its base or stem would be an obvious manner of attaching one element to another dependent upon the manner used in manufacturing the cap and is simply the result of optimization of the prior art teachings through routine experimentation, which is not a matter of invention, absent a showing to the contrary (see *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), and *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969)).

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26. Claims 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Trabattoni. Although Gueret fails to disclose that the body of the lip product applicator has an opening to receive a top portion of another product container, attention is directed to Trabattoni who discloses another lip product applicator having an opening to receive a top portion of another cosmetic product container. It would have been obvious to one of ordinary skill in the lip product applicator art, at the time the invention was made, to form the body of Gueret with an opening to receive a top portion of another cosmetic product container in view of the teachings of Trabattoni in order to conveniently provide the user with another often used cosmetic product that may be needed for touch-ups and thus reduce the number of containers that a user has to carry in one's pocket or purse. With regard to claim 8, Trabattoni further teaches the obviousness of the other cosmetic product in the container being nail polish. With respect to claims 7 and 9-14, although it is considered that the additional cosmetic product necessary to be contained in the other container is considered to be an obvious expedient to the skilled artisan dependent upon the combination of products that women desire to carry in their pocket or purse, to use another cosmetic product such as fragrance, face cream, lip gloss, eye shadow, eye liner, powder or cream, as called for by claims 7 and 9-14, to effect the combination of the lip product with another cosmetic product is simply the result of optimization of the prior art teachings through routine experimentation, which is not a matter of invention, absent a showing to the contrary (see *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), and *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969)).

### ***Conclusion***

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044.

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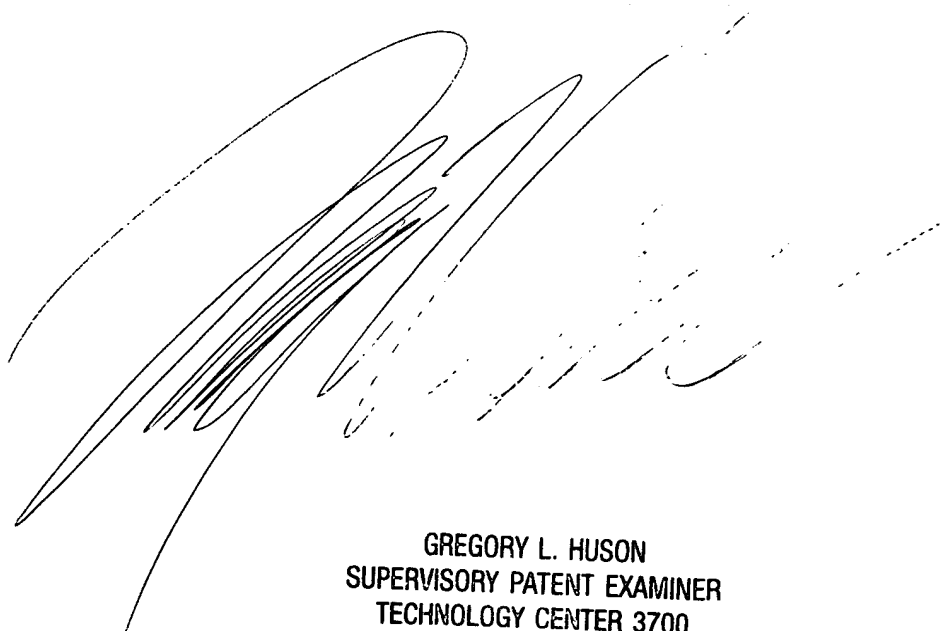
28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen J. Prunner

April 27, 2004



GREGORY L. HUSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700